

REMARKS

In the Office Action mailed October 29, 2010, the Examiner rejected claims 24-27, 29-35 and 47-55. By way of the foregoing amendments and the markings to show changes claims 24, 26-27, 29, 31, 32-34, 47-48, 50-53, and 55 have been amended; claims 1-23, 25, 28, 30, and 36-46 have been cancelled; and claims 56-57 are new. Claims 24, 26-27, 29, 31-35, and 47-57 are currently pending. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

I) PETITION FOR EXTENSION OF TIME

Applicants respectfully request and petition an appropriate extension of time to respond to the outstanding Office Action, of three months. The Commissioner is hereby authorized to charge Deposit Account No. 50-1097 for the three-month extension fee and for any deficiencies or overpayments which may be due in the name of Dobrusin & Thennisch PC.

II) Telephonic Interview

Applicants would like to thank Examiner Nguyen for the time and courtesy extended to Applicants' representative Daniel Aleksynas during a telephonic interview conducted on April 27, 2011. In that interview a proposed amendment and the 35 U.S.C. §§102 and 103 rejections in view of Toda were discussed. Examiner indicated that he would reconsider the rejections in view of the amendments and arguments when filed.

III) Claim Amendments and New Claims

New claims 56-57 have been added and claims 24, 26-27, 31, 33-34, 47-48, 50-53, and 55 have been amended. No new matter has been added. Support for the new claims and

claim amendments may be found throughout the specification of U.S. Patent Application Publication 2007/0214969 specifically paragraphs 0024, 0025, 0028, and 0044.

IV) Claim Rejections 35 U.S.C. § 102

The office action rejected claims 24, 26, 27, and 31-35 as being anticipated by Toda (WO 00/59689). Applicants traverse the rejections for the reasons stated herein.

The office action has not performed fact finding illustrating where each and every element of claim 24 and its dependents is found in Toda. For example, the office action has not performed fact finding as to where Toda teaches "a conveyor belt." The office action has further failed to present facts as to where Toda teaches "connecting a means to an end of the at least two food product blocks to create a connection," or "wherein the gripper is not driven by its own drive at least during contact with the food product block." The office action has further failed to perform fact finding illustrating where Toda teaches "wherein the connection between the means and the at least two food product blocks occurs after slicing of one or more of the at least two food product blocks beings." (Emphasis Added) Without the office action performing fact finding and presenting facts as each of these elements Applicants do not believe that a proper anticipation rejection of claim 24 has been presented.

The office action has not performed fact finding as to claim 26. For example, the office action has not performed fact finding illustrating where Toda teaches, "at least one conveyor belt." The office action has not performed fact finding showing where Toda teaches, "wherein at any time during slicing of the food product block, the rear end of the food product block is brought into contact in each case with a means," or "wherein the means serves merely to hold and not to drive the food product block." Without the office action performing fact finding and presenting facts as each of these elements Applicants do not believe that a proper anticipation rejection of claim 26 has been presented.

The office action has not performed fact finding as to claim 31, which states, "further comprising the step of removing the means from the feed passage after slicing, and brining the means up to an end of a new product block to be cut." The office action has not performed fact finding as to claim 32, which states, "wherein the connection between the means and the food product block is broken once slicing of the at least one food product block is complete." Furthermore, the office action has merely alleges "it is inherent that when the end of the food block reaches the blade, the connection between the food block and the means 36 is broken." The office action has failed to present any—rationale or evidence tending to show inherency—as required in MPEP 2112IV Applicants traverse the rejections made using inherency because

the rejections are mere conclusions and no factual or evidentiary support for these rejections is provided. Foremost, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP 2112IV (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The office action has failed to provide any basis in fact or technical reasoning to support the inherent characteristics alleged. The office action has further failed to show that these "inherent characteristics" necessarily flow from the teachings of the applied prior art. Applicants point out that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." MPEP 2112IV (quoting *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)) (emphasis in original). Furthermore, "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." MPEP 2112IV (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). For the reasons stated herein Applicants do not believe that the office action has presented a proper prima facie anticipation rejection. Applicants respectfully request that the rejections be withdrawn and the claims allowed.

V) Claim Rejections 35 U.S.C. § 103

a. Paragraph 4

The office action rejected claims 29 and 49-51 as being obvious over Toda in view of FR 2677573. Applicants traverse the rejections for the reasons stated herein.

i. Lack of Fact Finding

The office action in rejecting claims 29 and 49-51 has not performed any fact finding illustrating how FR2677573 cures the defects discussed above regarding claims 24 and 26 from which claims 29 and 49-51 depend. Applicants renew the comments herein discussed in section (II). Thus, Applicants do not believe that a proper prima facie obviousness rejection has been presented.

ii. Improper Application of KSR

Under *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007) in light of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), Applicants believe that a proper

35 U.S.C. § 103 rejection was not made. Although the teaching-suggestion-motivation (TSM) test requirements as applied in *KSR* have been altered to be applied in a less rigid manner, no explanation has been made showing the reasoning to combine Toda and FR2677573. The Court in *KSR* said:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**. (emphasis added)

The office action has merely concluded that Toda and FR2677573 are combinable without performing any of the analysis required under *KSR*. For example, the office action has not presented any facts and/or evidence as to why one skilled in the art would add the gripper of FR2677573 to Toda. Without this analysis Applicants do not believe that a proper prima facie obviousness rejection has been presented, and Applicants respectfully request that the rejection be withdrawn.

b. Paragraph 5

The office action further rejected claims 24, 26, 27, 29, 31-35, and 47-55 as being obvious in view of Toda in view of Lindee (6,935,215). Applicants traverse the rejections for the reasons stated herein.

i. Lack of Fact Finding

The office action has not performed fact finding as to every element of claim 24. For example, the office action has not performed fact finding as to "connecting a means to an end of the at least two food product blocks to create a connection, remote from the blade, of each of the at least two food product blocks." (emphasis added) Furthermore, Applicants believe that the facts presented by the office action that the "connecting means 36" actually forms a connection is not supported by substantial evidence. Applicants invite the Examiner to present facts supported by substantial evidence supporting this assertion.

The office action has not performed any fact finding showing where a reference of record teaches, "wherein the connection between the means and the at least two food product blocks occurs after slicing of one or more of the at least two food product blocks begins." (emphasis added) Applicants do not believe that a proper prima facie obviousness rejection has been presented and Applicants respectfully request that the rejections be withdrawn.

The office action has not performed fact finding as to claims 29, 47, and 49-51, which state, "wherein the means is connected to the food product block reversibly and force-lockingly, interlockingly, and/or by material bonding." The office action has not performed fact finding as to claim 31, which states, "further comprising the step of removing the means from the feed passage after slicing, and bringing the means up to an end of the a new product block to be cut." The office action has not performed any fact finding as to claim 32, which states, "wherein the connection between the means and the food product block is broken once slicing of the at least one food product block is complete." The office action has not performed any fact finding or analysis to establish that this element of claim 32 is inherent see section II, which is incorporated by reference herein. Moreover, as discussed herein the office action has not presented any facts to demonstrate that a connection is formed, thus, Applicants are unsure how the connection is then "broken." Applicants respectfully request that the Examiner provide a more explanation regarding this element. The office action has not performed any fact finding as to claims 47 and 50, which state, "wherein the means is driven, at least at times, solely by the at least one conveyor belt of the food product block, the food product block, or both. The office action has not performed any fact finding as to claims 48 and 51, which state, "wherein at least towards the end of the respective slicing process, the means is/are in each case engaged with the at least one conveyor belt."

The office action has not performed fact finding as to every element of claim 26. For example, the office action has not performed fact finding showing where a reference of record teaches." The office action has further failed to perform fact finding showing where a reference of record teaches, "wherein the means is driven by the food product block, the conveyor belt, or both during contact with the food product block." Applicants do not believe that a proper prima facie obviousness rejection has been presented and Applicants respectfully request that the rejections be withdrawn.

The office action has not performed fact finding as to every element of claim 55. For example, the office action has not performed fact finding as to "attaching a gripper to an end, remote from the blade, of each of the at least two food product blocks"; driving the grippers that are attached to each of the at least two food product blocks, at least part of the time, using only the at least one conveyor belt, one of the at least two food product blocks, or both"; "engaging the at least two food product blocks with the at least one conveyor belt"; and "wherein the grippers attach to the ends of the at least two food product blocks after slicing of the at least two product blocks has begun."

The office action has not performed any fact finding as to claim 56, which states, "wherein the gripper is not driven by its own drive at least during contact with the food product block." The office action has not performed any fact finding as to claim 57, which states, "further including the step of removing the gripper from the at least one conveyor belt, in a direction transverse to the conveyor belt, once slicing is complete." Applicants do not believe that the office action has presented a proper prima facie obviousness rejection. Thus, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

ii. Improper Application of KSR

Under *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007) in light of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), Applicants believe that a proper 35 U.S.C. § 103 rejection was not made. Although the teaching-suggestion-motivation (TSM) test requirements as applied in *KSR* have been altered to be applied in a less rigid manner, no explanation has been made showing the reasoning to combine Toda and FR2677573. The Court in *KSR* said:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**. (emphasis added)

The office action has merely concluded that Toda and Lindee are combinable without performing any of the analysis required under *KSR*. Without this analysis Applicants do not believe that a proper prima facie obviousness rejection has been presented, and Applicants respectfully request that the rejection be withdrawn.


CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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